



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,278	09/27/2004	Noriyuki Yamamoto	450100-04446	7653
7590 William S. Frommer Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151				
EXAMINER MORRISON, JAY A				
ART UNIT		PAPER NUMBER		
2168				
MAIL DATE		DELIVERY MODE		
09/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,278

Applicant(s)

YAMAMOTO ET AL.

Examiner

JAY A. MORRISON

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-15, 18-21, 23-29, 31, 32, 34-38, 40-44 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-15, 18-21, 23-29, 31, 32, 34-38, 40-44 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Remarks

1. Claims 1-6, 9-15, 18-21, 23-29, 31, 32, 34-38, 40-44 and 46-48 are pending.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "computer-readable medium" as in claims 21, 32 and 48 is not defined in the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3-6, 9-11, 13-15, 18-21, 23, 25, 31-32, 34, 36-38, 40-41, 43-44 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikugawa (Patent Number 7,111,042) in view of Abecassis (Patent Number 6,011,895).

As per claim 1, Kikugawa teaches

An information search system having an information processing apparatus and an information search apparatus which is accessed by the information processing apparatus via a network, the information processing apparatus comprising: (see abstract and background)

extraction means for analyzing an electronic mail message associated with a user to extract an interest word; (email from user containing notable word in text, column 8, lines 15-20; Fig. 3, item 103)

means for sending a request to the information search apparatus to search information based on the extracted interest word; (database search done when notable word exists in message, column 6, lines 54-57)

and means for receiving information identified in the search from the information search apparatus; (records with notable word "ski" returned from database, column 7, lines 26-32)

the information search apparatus comprising: means for accumulating the information; (collect advertising including text data, column 7, lines 43-46)

means for searching the accumulated information for information associated with the extracted interest word in response to the search request; (database search done when notable word exists in message, column 6, lines 54-57)

and means for sending the information identified by the search to the information processing apparatus. (advertising sentences related to a word, column 7, lines 50-52)

Kikugawa does not explicitly indicate "program" or "for obtaining information about a program".

However, Abecassis discloses "program" (video program, column 15, lines 21-23) and "for obtaining information about a program" (information about segments, column 15, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kikugawa and Abecassis because using the steps of "program" or "for obtaining information about a program" would have given those skilled in the art the tools to improve the invention by allowing database architecture that would permit keyword and interactive searches. This gives the user the advantage of more choices for viewer program selection.

As per claim 3, Kikugawa teaches
the information processing apparatus further comprises means for generating a database containing the extracted interest word. (column 6, lines 14-16)

As per claim 4,
Kikugawa does not explicitly indicate "the information processing apparatus further comprises means for controlling the recording of the program based on the received program information".

However, Abecassis discloses "the information processing apparatus further comprises means for controlling the recording of the program based on the received program information" (column 7, lines 8-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kikugawa and Abecassis because using the steps of "the information processing apparatus further comprises means for controlling the recording of the program based on the received program information" would have given

those skilled in the art the tools to improve the invention by allowing database architecture that would permit keyword and interactive searches. This gives the user the advantage of more choices for viewer program selection.

As per claim 5,

Kikugawa does not explicitly indicate "the information processing apparatus further comprises means for controlling the display of the received program information".

However, Abecassis discloses "the information processing apparatus further comprises means for controlling the display of the received program information" (column 7, lines 20-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kikugawa and Abecassis because using the steps of "the information processing apparatus further comprises means for controlling the display of the received program information" would have given those skilled in the art the tools to improve the invention by allowing database architecture that would permit keyword and interactive searches. This gives the user the advantage of more choices for viewer program selection.

As per claim 6,

Kikugawa does not explicitly indicate "the means for accumulating includes means for making a database by relating the program information with the program".

However, Abecassis discloses "the means for accumulating includes means for making a database by relating the program information with the program" (information about segments, column 15, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kikugawa and Abecassis because using the steps of "the means for accumulating includes means for making a database by relating the program information with the program" would have given those skilled in the art the tools to improve the invention by allowing database architecture that would permit keyword and interactive searches. This gives the user the advantage of more choices for viewer program selection.

As per claim 9,

Kikugawa does not expressly show "the received program information includes a recording start time, a recording end time, and channel information for recording the program".

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The content of the program information does not affect the performed steps since it is not functionally involved. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use various timer-recording information because such data does not functionally relate to the steps in the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 10, Kikugawa teaches

the information processing apparatus acquires the electronic mail message from another information processing apparatus. (column 8, lines 14-18)

As per claims 11, 13-15 and 18-19,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1, 3-4, 6 and 9-10 and are similarly rejected.

As per claims 20-21,

These claims are respectively rejected on grounds corresponding to the arguments given above for rejected claim 1 and are similarly rejected.

As per claim 23, Kikugawa teaches

An information search apparatus, comprising: (see abstract and background) means for accumulating information; (collect advertising including text data, column 7, lines 43-46)

means for receiving an interest word sent from an information processing apparatus, the interest word having been extracted from an electronic mail message associated with a user; (email from user containing notable word in text, column 8, lines 15-20; Fig. 3, item 103)

means for searching the accumulated information based on the extracted interest word; (database search done when notable word exists in message, column 6, lines 54-57)

and means for sending information identified in the search to the information processing apparatus. (records with notable word "ski" returned from database, column 7, lines 26-32)

Kikugawa does not explicitly indicate "program information associated with a program".

However, Abecassis discloses "program information associated with a program" (information about segments, column 15, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kikugawa and Abecassis because using the steps of "program information associated with a program" would have given those skilled in the art the tools to improve the invention by allowing database architecture that would permit keyword and interactive searches. This gives the user the advantage of more choices for viewer program selection.

As per claim 25,

Kikugawa does not expressly show "the sent program information contains a recording start time, a recording end time, and a channel information for recording the program".

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The content of the program information does not affect the performed steps since it is not functionally involved. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use various timer-recording information because such data does not functionally relate to the steps in the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 31-32,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 23 and are similarly rejected.

As per claims 34 and 36-37,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1, 4 and 6, and are similarly rejected.

As per claim 38,

Kikugawa does not expressly show "the electronic mail message includes at least one of a program name, a genre name, and a cast name".

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The content of the timer-recording information does not affect the performed steps since it is not functionally involved. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use various timer-recording information because such data does not functionally relate to the steps in the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 40,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 9 and is similarly rejected.

As per claims 41, 43-44 and 46,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1, 4, 38 and 9, respectively, and are similarly rejected.

As per claims 47-48,

These claims are respectively rejected on grounds corresponding to the arguments given above for rejected claim 1 and are similarly rejected.

5. Claims 2, 12, 24, 35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikugawa (Patent Number 7,111,042) in view of Abecassis (Patent Number 6,011,895) and further in view of Buskirk, Jr. et al. ('Buskirk' hereinafter) (Patent Number 6,424,997).

As per claim 2,

Neither Kikugawa nor Abecassis explicitly indicate "the extraction means includes means for performing morphological analysis on the electronic mail message to identify the interest word".

However, Buskirk discloses "the extraction means includes means for performing morphological analysis on the electronic mail message to identify the interest word" (morphological analysis of electronic mail text, abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kikugawa, Abecassis and Buskirk because using the steps of “the extraction means includes means for performing morphological analysis on the electronic mail message to identify the interest word” would have given those skilled in the art the tools to improve the invention by determining the appropriate action to effect on the message. This gives the user the advantage of automatic processing of incoming email in order to save time via automation.

As per claims 12, 24, 35 and 42,

These claims are rejected on grounds corresponding to the arguments given above for rejected claim 2 and are similarly rejected.

6. Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikugawa (Patent Number 7,111,042) in view of Abecassis (Patent Number 6,011,895) and further in view of Aoki et al. (‘Aoki’ hereinafter) (Patent Number 7,107,271).

As per claim 26,

Neither Kikugawa nor Abecassis explicitly indicate “means for analyzing the program information; means for generating dictionary data for relating a genre of the program information with a keyword based on the analysis; and database generation

means for assigning a genre to the program information based on the dictionary data and storing the program information”

However, Aoki discloses “means for analyzing the program information;” (column 6, lines 29-36) “means for generating dictionary data for relating a genre of the program information with a keyword based on the analysis;” (column 7, lines 13-16) “and database generation means for assigning a genre to the program information based on the dictionary data and storing the program information” (column 7, lines 9-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kikugawa, Abecassis and Aoki because using the steps of “means for analyzing the program information; means for generating dictionary data for relating a genre of the program information with a keyword based on the analysis; and database generation means for assigning a genre to the program information based on the dictionary data and storing the program information” would have given those skilled in the art the tools to improve the invention by enable the viewing of desired programs that might otherwise be missed. This gives the user the advantage of better access to desired programming.

As per claim 27,

Neither Kikugawa nor Abecassis explicitly indicate “means for: extracting a keyword from the interest word, identifying a genre corresponding to the keyword by searching the dictionary data based on the keyword, and searching the program information based on the genre”

However, Aoki discloses “means for: extracting a keyword from the interest word, identifying a genre corresponding to the keyword by searching the dictionary data based on the keyword, and searching the program information based on the genre” (column 7, lines 14-18)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kikugawa, Abecassis and Aoki because using the steps of “means for: extracting a keyword from the interest word, identifying a genre corresponding to the keyword by searching the dictionary data based on the keyword, and searching the program information based on the genre” would have given those skilled in the art the tools to improve the invention by enable the viewing of desired programs that might otherwise be missed. This gives the user the advantage of better access to desired programming.

As per claim 28,

Neither Kikugawa nor Abecassis explicitly indicate “the means for generating dictionary data has keyword detection means for detecting a word contained in metadata of a genre among, as a keyword of the genre”.

However, Aoki discloses “the means for generating dictionary data has keyword detection means for detecting a word contained in metadata of a genre among, as a keyword of the genre” (column 7, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kikugawa, Abecassis and Aoki because using the steps

of "the means for generating dictionary data has keyword detection means for detecting a word contained in metadata of a genre among, as a keyword of the genre" would have given those skilled in the art the tools to improve the invention by enable the viewing of desired programs that might otherwise be missed. This gives the user the advantage of better access to desired programming.

As per claim 29,

Neither Kikugawa nor Abecassis explicitly indicate "the means for generating dictionary data generates the dictionary data by storing, with the keyword, a frequency at which keyword is detected".

However, Aoki discloses "the means for generating dictionary data generates the dictionary data by storing, with the keyword, a frequency at which keyword is detected" (column 5, lines 26-32)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kikugawa, Abecassis and Aoki because using the steps of "the means for generating dictionary data generates the dictionary data by storing, with the keyword, a frequency at which keyword is detected" would have given those skilled in the art the tools to improve the invention by enable the viewing of desired programs that might otherwise be missed. This gives the user the advantage of better access to desired programming.

Response to Arguments

7. Applicant's arguments, see pages 18-19, filed 6/17/2008, with respect to the 35 USC 101 rejections of claims 1-6, 9-15, 18-19, 23-29, 34-38, 40-44 and 46 as non-statutory have been fully considered and are persuasive. The rejection under 35 USC 101 of claims 1-6, 9-15, 18-19, 23-29, 34-38, 40-44 and 46 as non-statutory has been withdrawn. It is noted that for purposes of examination the means-for language recited in these claims is defined to be hardware as specified by the applicant in his response (applicant arguments received 6/17/2008, page 19, second paragraph).

8. Applicant's arguments filed 6/17/2008 have been fully considered but they are not persuasive. With respect to the applicants arguments that Abecassis does not disclose "analyzing an electronic mail message ... to extract an interest word ... sending a request ... to search program information based on the extracted interest word ... [and] sending program information identified by the search to the information processing apparatus", it is respectfully submitted that Abecassis does disclose program information as information about segments of a video program (column 15, lines 15-23). With respect to the remaining limitations, it is submitted that Applicant's arguments with respect to claims 1-6, 9-15, 18-21, 23-29, 31, 32, 34-38, 40-44 and 46-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tim T. Vo/
Supervisory Patent Examiner, Art Unit 2168

Jay Morrison
TC2100

Tim Vo
TC2100